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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/045,386 03/20/98 WALKER

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022927
WALKER DIGITAL
FIVE HIGH RIDGE PARK
STAMFORD CT 06905

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EXAMINER

NGUYEN, J

ART UNIT

PAPER NUMBER

2166

DATE MAILED:

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/045,386

Applicant(s)

WALKER ET AL.

Examiner

Leslie K. Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 35 and 36 is/are allowed.
- 6) ☒ Claim(s) 1-34, 37, and 38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

Detailed Action

1. This action is responsive to the amendment filed 18 December 2000. As per Applicant's request, claims 1-3, 5-7, 15-24, and 27-32 have been amended. Claims 37 and 38 have been added. Claims 4, 8-14, 25, 26, and 33-36 remain pending in the application.
2. The specification has been amended to correct the minor informalities. The Examiner withdraws the objection to the specification.
3. The Examiner withdraws the allowance of claims 9-14, 25, 26, 33, and 34 in view of newly discovered prior art. Please see the claim rejections below for prior art and reasoning.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 1-8 and 15-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Katz et al. in U.S. Pat. No. 6,055,513.

As per claim 1, Katz et al. disclose a method for controlling the performance of a supplementary process at a point-of-sale terminal, comprising:

- measuring an activity rate of a point-of-sale terminal (col. 9, lines 22-42, specifically “customer number” of line 26); and
- providing a product offer in accordance with the activity rate (col. 11, lines 32-33).

As per claim 2, Katz et al. disclose the method of claim 1. Katz et al. further disclose that the step of providing a product offer comprises:

- disabling a system for providing a product offer if the activity rate is greater than a predetermined threshold (col. 10, lines 56-62; col. 11, lines 15-21; and col. 24, line 61 – col. 25, line 4).

As per claim 3, Katz et al. disclose the method of claim 1. Katz et al. further disclose that the step of providing a product offer comprises:

- enabling a system for providing a product offer if the activity rate is less than a predetermined threshold (col. 10, lines 56-62; col. 11, lines 15-21; and col. 24, line 61 – col. 25, line 4).

As per claim 4, Katz et al. disclose the method of claim 1, further comprising:

- determining a predetermined threshold in dependence on a signal indicative of time of day (col. 10, lines 56-62; col. 11, lines 15-21; and col. 24, line 61 – col. 25, line 4).

Claims 5-8 claim the apparatus necessary to carry out the functions claimed in method claims 1-4. Therefore, claims 5-8 are rejected upon the same grounds as claims 1-4 as addressed above.

As per claim 15, Katz et al. disclose a method for controlling the performance of a supplementary process at a point-of-sale terminal, comprising:

- measuring a criterion (col. 10, lines 56-62; col. 11, lines 15-21; and col. 24, line 61 – col. 25, line 4);

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- determining, based on the criterion, whether to disable a system for providing a product offer (col. 10, lines 56-62; col. 11, lines 15-21; and col. 24, line 61 – col. 25, line 4); and
- disabling the system for providing a product offer (col. 10, lines 56-62; col. 11, lines 15-21; and col. 24, line 61 – col. 25, line 4).

As per claim 17, Katz et al. disclose a method for controlling the performance of a supplementary process at a point-of-sale terminal, comprising:

- measuring a criterion (col. 10, lines 56-62; col. 11, lines 15-21; and col. 24, line 61 – col. 25, line 4);
- determining, based on the criterion, whether to enable a system for providing a product offer (col. 10, lines 56-62; col. 11, lines 15-21; and col. 24, line 61 – col. 25, line 4); and
- enabling the system for providing a product offer (col. 10, lines 56-62; col. 11, lines 15-21; and col. 24, line 61 – col. 25, line 4).

Claims 16 and 18 claim the apparatus necessary to carry out the functions claimed in method claims 15 and 17, respectively. Therefore, claims 16 and 18 are rejected upon the same grounds as claims 15 and 17, respectively, as addressed above.

As per claim 19, Katz et al. disclose a method for controlling the performance of a supplementary process at a point-of-sale terminal, comprising:

- measuring an activity rate of a plurality of point-of-sale terminals (col. 9, lines 22-42, specifically “customer number” of line 26);

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- determining, based on the activity rate, whether to perform a product offer (col. 10, lines 56-62; col. 11, lines 15-21; and col. 24, line 61 – col. 25, line 4); and
- providing the product offer at at least one point-of-sale terminal (col. 10, lines 56-62; col. 11, lines 15-21; and col. 24, line 61 – col. 25, line 4).

As per claim 20, Katz et al. disclose the method of claim 19. Katz et al. further disclose that the step of providing the product offer comprises:

- providing the product offer at each point-of-sale terminal (col. 10, lines 56-62; col. 11, lines 15-21; and col. 24, line 61 – col. 25, line 4).

Claims 21 and 22 claim the apparatus necessary to carry out the functions claimed in method claims 19 and 20, respectively. Therefore, claims 21 and 22 are rejected upon the same grounds as claims 19 and 20, respectively, as addressed above.

As per claim 23, Katz et al. disclose a method for controlling the performance of a supplementary process at a point-of-sale terminal, comprising:

- measuring an activity rate of a plurality of point-of-sale terminals (col. 9, lines 22-42, specifically “customer number” of line 26);
- determining, based on the activity rate, whether to disable a system for providing a product offer (col. 10, lines 56-62; col. 11, lines 15-21; and col. 24, line 61 – col. 25, line 4); and
- disabling a system for providing a product offer for each of a plurality of point-of-sale terminals (col. 10, lines 56-62; col. 11, lines 15-21; and col. 24, line 61 – col. 25, line 4).

Claim 24 claims the apparatus necessary to carry out the functions claimed in method claim 23. Therefore, claim 24 is rejected upon the same grounds as claim 23 as addressed above.

As per claim 25, Katz et al. disclose a method of controlling the performance of a supplementary process at a point-of-sale terminal, comprising:

- measuring an activity rate of a point-of-sale terminal (col. 9, lines 22-42, specifically “customer number” of line 26); and
- if the activity rate is less than a predetermined threshold,
 - determining an upsell in dependence on a purchase (col. 8, lines 56-62; col. 9, lines 2-5; and col. 14, lines 48-56);
 - determining an upsell price in dependence on the purchase (col. 8, lines 56-62; col. 9, lines 2-5; and col. 14, lines 48-56); and
 - offering to exchange the upsell price for the upsell (col. 8, lines 56-62; col. 9, lines 2-5; and col. 14, lines 48-56).

Claim 26 claims the apparatus necessary to carry out the functions claimed in method claim 25. Therefore, claim 26 is rejected upon the same grounds as claim 25 as addressed above.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al. in U.S. Pat. No. 6,055,513 in view of Deaton et al. in U.S. Pat. No. 5,621,812.

As per claim 9, Katz et al. disclose a method for controlling the performance of a supplementary process at a point-of-sale terminal, comprising:

- measuring an activity rate of a point-of-sale terminal (col. 9, lines 22-42, specifically “customer number” of line 26); and
- providing a supplementary product offer in accordance with the activity rate (col. 10, lines 56-62; col. 11, lines 15-21; and col. 24, line 61 – col. 25, line 4).

However, Katz et al. do not disclose that the step of providing a supplementary product offer is done in accordance with an offer schedule. Deaton et al. teach the step of providing a supplementary product offer is done in accordance with an offer schedule (col. 62, line 40 – col. 68, line 14). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Deaton et al. into the invention of Katz et al. The invention of Katz et al. is enhanced since product offers are given out more effectively and not given out arbitrarily.

As per claim 10, Katz et al. disclose the method of claim 9. Katz et al. do not disclose that the offer schedule comprises a set of supplementary product offers, each supplementary product offer corresponding to a predetermined range of activity rates. Deaton et al. disclose an offer schedule that comprises a set of supplementary product offers, each supplementary product offer corresponding to a predetermined range of activity rates (col. 64, line 40 – col. 68, line 14). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Deaton et al. into the invention of Katz et al. The invention of Katz et al. is enhanced since product offers are given out more effectively and not given out arbitrarily.

Claim 11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 12-14 claim the apparatus necessary to carry out the functions claimed in method claims 9-11. Therefore, claims 12-14 are rejected upon the same grounds as claims 9-11 as addressed above.

8. Claims 27-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al. in U.S. Pat. No. 6,055,513.

As per claim 27, Katz et al. disclose a method for controlling the performance of a supplementary process at a point-of-sale terminal, comprising providing a product offer. However, Katz et al. do not teach receiving an override signal nor providing a product offer in accordance with the override signal. The Examiner takes Official Notice and asserts that it is well known to provide override means at a specific point-of-sale terminal (override button with appropriate access/manager code). Also, the Examiner takes Official Notice and asserts that it is well to provide override means to remote terminals connected to a management terminal via a network. It would have been obvious to one of ordinary skill in the art to incorporate these well-known teachings into the invention of Katz et al. The invention of Katz et al. is enhanced since the possible loss of business is reduced with the option to override the decision to provide or not provide a product offer.

As per claim 28, Katz et al. disclose the method of claim 27. Katz et al. do not specifically teach that the step of providing comprises disabling a system for providing a product

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offer if the override signal does not indicate provision of the product offer. The Examiner takes Official Notice and asserts that it is well known to:

- provide override means at a specific point-of-sale terminal (override button with appropriate access/manager code);
- provide override means to remote terminals connected to a management terminal via a network; and
- void additional transactions at point-of-sale terminals (cancel purchases, coupons, etc.) based on override signals.

It would have been obvious to one of ordinary skill in the art to incorporate these well-known teachings into the invention of Katz et al. The invention of Katz et al. is enhanced since the possible loss of business is reduced with the option to override the decision to provide or not provide a product offer.

As per claim 29, Katz et al. disclose the method of claim 27. Katz et al. do not specifically teach that the step of providing comprises enabling a system for providing a product offer if the override signal indicates provision of the product offer. The Examiner takes Official Notice and asserts that it is well known to:

- provide override means at a specific point-of-sale terminal (override button with appropriate access/manager code);
- provide override means to remote terminals connected to a management terminal via a network; and
- input additional transactions at point-of-sale terminals (entering additional purchases, coupons, etc.) based on override signals.

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It would have been obvious to one of ordinary skill in the art to incorporate these well-known teachings into the invention of Katz et al. The invention of Katz et al. is enhanced since the possible loss of business is reduced with the option to override the decision to provide or not provide a product offer.

Claims 30-33 claim the apparatus necessary to carry out the functions claimed in method claims 27-29. Therefore, claims 30-33 are rejected upon the same grounds as claims 27-29 as addressed above.

9. Claims 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al. in U.S. Pat. No. 6,055,513 in view of Burke in U.S. Pat. No. 5,621,640.

As per claim 37, Katz et al. disclose a method for controlling the performance of a supplementary process at a point-of-sale terminal, comprising:

- measuring an activity rate of a point-of-sale terminal (col. 9, lines 22-42, specifically “customer number” of line 26); and
- if the activity rate is less than a predetermined threshold,
 - determining an upsell in dependence on a purchase (col. 8, lines 56-62; col. 9, lines 2-5; and col. 14, lines 48-56);
 - determining an upsell price (col. 8, lines 56-62; col. 9, lines 2-5; and col. 14, lines 48-56); and
 - offering to exchange the upsell price for the upsell (col. 8, lines 56-62; col. 9, lines 2-5; and col. 14, lines 48-56).

Katz et al. do not teach that the upsell price is dependent on change due from the purchase.

Burke teaches determining an upsell price in dependence on change due from a purchase (col. 1,

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lines 37-50 and col. 2, line 60 – col. 3, line 58). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Burke into the invention of Katz et al. The invention of Katz et al. is enhanced since the additional customer enticement will bring in more revenue to the business.

Claim 38 claims the apparatus necessary to carry out the functions claimed in method claim 37. Therefore, claim 38 is rejected upon the same grounds as claim 37 as addressed above.

Allowable Subject Matter

10. In view of the newly discovered prior art, claims 35 and 36 remain allowable as stated in the prior Office Action.

Remarks

11. In view of Applicant's amendments of claims, the Examiner has provided new prior art rejections and withdrawn some allowances. Applicant's remarks concerning 102 and 103 rejections (on pages 7 and 8 of Paper No. 9) in view of Oka in U.S. Pat. No. 5,408,210 are noted but are now moot due to Examiner's new rejections.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Beach et al. teach a computer based system for monitoring and processing data collected at the point of sale of goods and services.

- Kanter teaches a referral recognition system for an incentive award program.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie K. Nguyen whose telephone number is 703-306-5540.

The examiner can normally be reached on Monday-Friday, 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq R. Hafiz can be reached on 703-305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-9051 for regular communications and 703-308-9051 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Leslie K. Nguyen
March 7, 2001



TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100